

## **REMARKS**

In the Office Action, the Examiner rejected claims 1-3, 5, 7, 9, and 14-19 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,946,457 to Nakai et al. (“Nakai”); rejected claims 4, 6, 10, and 13<sup>1</sup> under 35 U.S.C. §103(a) as being unpatentable over Nakai in view of Japanese Patent No. JP 10-42114 to Uchibori (“Uchibori”); rejected claim 8 under 35 U.S.C. §103(a) as being unpatentable over Nakai and Uchibori in view of U.S. Patent No. 5,414,494 to Aikens (“Aikens”); and rejected claims 11 and 12 under 35 U.S.C. §103(a) as being unpatentable over Nakai and Uchibori, and further in view of U.S. Patent No. 5,881,233 to Toyoda et al. (“Toyoda”).

### **Summary of Applicants’ Reply**

For the following reasons, Applicants traverse the Examiner’s rejections, and submit that pending claims 1-19 are allowable. Accordingly, Applicants respectfully request the timely reconsideration and allowance of pending claims 1-19.

### **Detailed Response**

#### **Rejections under 35 U.S.C. § 102(e)**

The rejection of claims 1-3, 5, 7, 9, and 14-19 as being anticipated by Nakai under 35 U.S.C. § 102(e) is respectfully traversed, since the cited art does not anticipate the claims. In order to properly anticipate Applicants’ claimed invention under 35 U.S.C. § 102(e), a single reference must teach each and every element of the claim in issue, either expressly or under

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<sup>1</sup> In the listing on page 7 of the Office Action, the Examiner indicated that claims 4, 6, 10, and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakai in view of Uchibori. However, the Examiner, in the reasoning on page 9, listed claim 13, instead of claim 12. Accordingly, Applicants believe that the Examiner intended to reject claim 13, but not claim 12 under this ground of rejection, and respond accordingly. The Examiner is requested to confirm Applicants’ assumption should the rejection be maintained.

principles of inherency. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the claim.” *See* M.P.E.P. § 2131(8<sup>th</sup> Ed. Aug. 2001), *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 (8<sup>th</sup> Ed. 2001). Applicants submit that these requirements have not been met for at least the following reasons.

Independent claim 1 recites a combination including, among other things, “transmitting means for reading the information relating to the document image stored in the storage means periodically and transmitting the document image ...to one of the at least one system.” Applicants submit that Uchibori does not disclose at least this combination of elements. The Examiner alleged that the “transmitting means” corresponds to a host computer (96a) in Nakai (cited to column 20, lines 6-24 of Nakai, *see* O.A. at p.3). In Nakai, this host computer receives image information (as opposed to information relating to the document image), and does so from a scanner (column 20, lines 14-16), as opposed to a storage means. Nothing in Nakai discloses that the host computer 96a reads “information relating to the document image stored in the storage means,” or that it does so “periodically,” as recited in claim 1. Accordingly, Applicants respectfully submit that Nakai does not anticipate a combination including, at least, “transmitting means for reading the information relating to the document image stored in the storage means periodically and transmitting the document image ...to one of the at least one system,” as recited in claim 1. Accordingly, claim 1 is allowable.

Furthermore, by virtue of their dependence from allowable claim 1, claims 2, 3, 5, 7, 9, and 14-18 are also allowable.

Independent claim 19 recites a combination including, among other things, “reading the stored information relating to the document image periodically and transmitting the document

image ...to the transmission destination.” For the reasons stated above, regarding claim 1, Nakai does not disclose at least “reading the stored information relating to the document image periodically and transmitting the document image ...to the transmission destination,” as recited in claim 19. Accordingly, claim 19 is allowable.

Rejections under 35 U.S.C. § 103(a)

The rejections of claims 4, 6, 8, and 10-13 as obvious under 35 U.S.C. § 103(a) are respectfully traversed, since the Examiner has not made a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the reference or references, taken alone or in combination, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” (*See* M.P.E.P. § 2143 (8<sup>th</sup> Ed. 2001)). Applicants submit that these requirements have not been met for at least the following reasons.

1. *Rejection of claims 4, 6, 10, and 13 under 35 U.S.C. §103(a) as being obvious over Nakai in view of Uchibori.*

Dependent claims 4, 6, 10, and 13, each by virtue of their dependence from independent claim 1, recite a combination including, for example, “transmitting means for reading the information relating to the document image stored in the storage means periodically and transmitting the document image ...to one of the at least one system.” As discussed above, with regard to claim 1, Nakai neither discloses nor suggests this feature. Furthermore, Applicants submit that Uchibori does not cure this deficiency-- that is, Uchibori also does not disclose or

suggest at least this feature. More specifically, in response to the previous rejection of claim 4, 6, 10, and 13, under Uchibori, Applicants demonstrated in the paper filed on January 7, 2004, that Uchibori failed to disclose this same feature. The Examiner has admitted that these arguments were persuasive. (See O.A., p. 2) Applicants therefore submit that Uchibori cannot cure Nakai's failure to disclose or suggest at least "transmitting means for reading the information relating to the document image stored in the storage means periodically and transmitting the document image ...to one of the at least one system," as recited in claims 4, 6, 10, and 13. Accordingly, claims 4, 6, 10, and 13 are therefore allowable.

2. *Rejection of claim 8 under 35 U.S.C. §103(a) as being obvious over Nakai and Uchibori in view of Aikens.*

Dependent claim 8, by virtue of its dependence from independent claim 1, recites a combination including, for example, "transmitting means for reading the information relating to the document image stored in the storage means periodically and transmitting the document image ...to one of the at least one system." As discussed above, with regard to claim 1, Nakai neither discloses nor suggests this feature. Furthermore, Applicants submit that neither Uchibori nor Aikens cures this deficiency-- that is, neither Aikens nor Uchibori disclose or suggest at least this feature. More specifically, in the January 7, 2004 response to the previous rejection of claim 8, under Uchibori and Aikens, Applicants showed that neither Uchibori nor Aikens disclosed or suggested this same feature. The Examiner has admitted that these arguments were persuasive. (See O.A., p. 2) Applicants therefore submit that neither Uchibori nor Aikens can cure Nakai's failure to disclose or suggest at least "transmitting means for reading the information relating to the document image stored in the storage means periodically and transmitting the document image ...to one of the at least one system," as recited in claim 8. Accordingly, claim 8 is therefore allowable.

3. *Rejection of claims 11 and 12 under 35 U.S.C. §103(a) as being obvious over Nakai and Uchibori, in view of Toyoda.*

Dependent claims 11 and 12, each by virtue of their dependence from independent claim 1, recite a combination including, for example, “transmitting means for reading the information relating to the document image stored in the storage means periodically and transmitting the document image ...to one of the at least one system.” As discussed above, with regard to claim 1, Nakai neither discloses nor suggests this feature. Furthermore, Applicants submit that neither Uchibori nor Toyoda cures this deficiency-- that is, neither Toyoda nor Uchibori disclose or suggest at least this feature. More specifically, as pointed out in their January 7, 2004 response to the previous rejection of claims 11 and 12, under Uchibori and Toyoda, Applicants demonstrated that neither Uchibori nor Toyoda disclosed or suggested this same feature. The Examiner has admitted that these arguments were persuasive. (See O.A., p. 2) Applicants therefore submit that neither Uchibori nor Toyoda can cure Nakai’s failure to disclose or suggest at least “transmitting means for reading the information relating to the document image stored in the storage means periodically and transmitting the document image ...to one of the at least one system,” as recited in claims 11 and 12. Accordingly, claims 11 and 12 are therefore allowable.

**Conclusion**

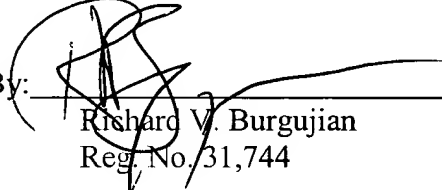
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of pending claims 1-19.

Please grant any extensions of time required to enter this response and charge any additional required fees to deposit account 06-0916.

Respectfully submitted,

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